REMARKS

Applicants appreciate the courtesies extended by the examiner to the undersigned attorney in a telephone interview conducted on December 5, 2003, wherein a new reference cited to replace a reference used to reject the claims that were appealed was discussed. This response contains the substance of the discussion about the new reference and applicants' position with regard to patentability of the claims.

As an initial matter, applicants assert that the examiner has improperly re-opened prosecution in a case that was finally decided on appeal with no remand to the examiner for further consideration. According to §1214.04 of the M.P.E.P., when the reversal by the Board does not contain a new ground of rejection:

> "The examiner should never regard such a reversal as a challenge to make a new search to uncover other and better references."
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> The M.P.E.P. further states that:
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> "If the examiner has specific knowledge of the existence of a particular reference or references which indicate nonpatentability of any of the appealed claims as to which the examiner was reversed, he or she should submit the matter to the Technology Center (TC) Director for authorization to reopen prosecution under 37 CFR 1.198 for the purpose of entering the new rejection. . . . The TC Director's approval is placed on the action reopening prosecution."

In this case, it appears that the knowledge of another reference is the result of a new search conducted by the examiner after the decision on appeal in order to uncover other references. The board did not remand the case to the examiner for continued prosecution or direct the examiner to conduct a new search. Hence, the examiner had no right under the rules or procedures to make a new search. If the examiner had specific knowledge of the newly cited reference prior to appeal, he should

have informed applicants so that the matter could have been handled prior to submitting the case to the Board for a decision. As a result of the improper action of the examiner, upon appeal of this case, the Board will be faced with deciding the same issues it decided in the previous appeal.

Furthermore, even if the examiner's actions were deemed to be proper, the new reference fails, as did all of the previous references, to provide sufficient motivation to modify the primary reference to obtain the claimed invention.

In view of the fact that the only difference in the new rejections from the previous rejections is the use of U.S. Patent No. 4,831,390 to Deshpande et al. to replace U.S. Patent No. 4,689,659 to Watanabe in all of the rejections, applicants do not believe it is necessary to restate what has already been stated about the other references with respect to the claims in the previous responses and appeal brief. Applicants' arguments with respect to the other references are already of record in this case and are referred to be reference thereto.

With regard to the combination of the '390 patent with the '816 patent, the '816 patent describes a recording head 16 that is attached to a tank holder. There is nothing in the '816 patent to suggest that the head itself is intended to be different from the printhead 11 of the '390 patent. In fact, the '816 patent states in column 8, lines 44-48 that the recording head 16 per se does not constitute the gist of the invention.

According to the '390 patent, the printhead 11 is attached to an electrode board 19 and to a cartridge 12. This construction is analogous to the recording head 16 and tank holder 11 of the '816 patent. The '390 patent also calls for a separate heat sink that is attached to the printhead 11 opposite the side of the printhead attached to the cartridge 12. Accordingly, three components are required to provide the structure of the '390 patent, namely, a printhead, a heat sink and a cartridge. In contrast, the '816 patent only calls for two components, the recording head 16 and the ink tank holder. A combination of the two references would suggest that a fin be placed on the recording

head component 16 of the '816 patent rather than on the tank holder 11 or that a separate heat sink component be used in addition to the recording head 16 and holder 11. A separate heat sink would have to be applied to the opposite side of the head from the cartridge holder 11 according to the '390 patent.

Applicants' invention calls for only two components, a substrate holder and a one or more semiconductor substrates attached to the holder. The semiconductor substrate together with a nozzle plate provides an ink jet recording head analogous to the recording head component 16 of the '816 patent or the printhead 11 of the '390 patent. In contrast to the combined references, it is the substrate holder of applicants' invention that has at least one side wall containing fins. In order to provide applicants' claimed invention, the references would have to suggest that the fins be applied to the tank holder 11 of the '816 patent or to the cartridge 12 of the '390 patent. Neither of these patents suggests such a construction. Accordingly, the examiner's reliance on the '390 patent fails to provide the claimed invention.

It should be abundantly clear from the foregoing discussion of the new reference in combination with the primary reference that the deficiencies of these references to provide the elements of the claimed invention applies to the other rejections set forth in the office action. Not only is the new reference commulative with previously cited references, the new reference leads one skilled in the art further from the invention than any of the other references.

In conclusion, it is submitted that the Examiner has engaged in impermissible hindsight reconstruction of the invention, by selectively choosing portions of the references and combining the portions of the references to provide the claimed invention without one scintilla of motivation from the references themselves to make a combination sufficient to provide the claimed invention. Furthermore, even if the references were combined as suggested by the Examiner, the combined references fail to provide all of the features and elements of the claimed invention. It is therefore requested

that the rejections of Claims 1-22 and 25-39 be withdrawn and the case immediately passed to allowance.

In the event this response is not timely filed, Applicants hereby petition for the appropriate extension of time and request that the fee for the extension along with any other fees which may be due with respect to this paper be charged to our **Deposit Account No. 12-2355.**

Respectfully submitted,
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I hereby certify that this correspondence consisting of 6 pages is being facsimile transmitted to the Patent and Trademark Office at (703) 872-9306;

On December 23, 2003
Date

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